

ESTTA Tracking number: **ESTTA524245**

Filing date: **02/28/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91202984
Party	Defendant Lauren R. Schneider
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Date	02/28/2013
Attachments	answer-to-amended-opposition.pdf (8 pages)(104310 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 85,240,605
Published in the *Official Gazette* on June 21, 2011
Mark: ELLE SCHNEIDER

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Hachette Filipacchi Presse,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91,202,984
	:	
Lauren R. Schneider,	:	
	:	
Respondent.	:	
----- X		

ANSWER TO AMMENDED OPPOSITION

Applicant, Lauren R. Schneider (hereinafter the “Applicant”) hereby answers the Amended Notice for Opposition of Hachette Filipacchi Presse (hereinafter the “Opposer”). Any allegations not specifically admitted hereinafter is denied by Applicant.

1. Opposer is the publisher of the fashion and beauty magazine sold under the mark ELLE, launched in the United States in 1985. ELLE is said to be the world’s largest fashion magazine, with 42 international editions in over 60 countries, with 23 million readers globally. The ELLE magazine features extensive photography spreads of fashion, celebrities and apparel created by famous and accomplished photographers. The ELLE magazine is extensively promoted on the Internet, at newsstands and elsewhere, and enjoys substantial sales and reputation.

ANSWER: Applicant is without knowledge sufficient to form a belief as to the truth or relevance of the allegations contained in paragraph 1 and therefore Applicant denies the same.

2. Since at least as early as 1991, Opposer has used in commerce the trademark ELLE ELLE DÉCOR for magazines featuring home design, decorating, entertainment, travel, dining, celebrities and shopping. ELLE DÉCOR has an audience of 1.7 million and was ranked the leading luxury design magazine for 2009 and 2010. The extensive photography spreads in ELLE DÉCOR magazine

have included celebrities and events at beautiful settings around the country and around the world.

ANSWER: Applicant is without knowledge sufficient to form a belief as to the truth or relevance of the allegations contained in paragraph 2 and therefore Applicant denies the same.

3. The ELLE.COM website features ELLE TV, featuring videos and film clips in the fields of fashion and accessories, hair and beauty, pop culture, film, news, life and love, shopping, and other topics of interest, plus links to third-party videos. The ELLE.COM and ELLE TV sites have literally millions of “hits” by consumers.

ANSWER: Applicant is without knowledge sufficient to form a belief as to the truth or relevance of the allegations contained in paragraph 3 and therefore Applicant denies the same.

4. The ELLE, ELLE DÉCOR and ELLE TV marks and ELLE.COM website have been extensively promoted and advertised for magazines and various merchandise related to fashion, beauty, celebrity style, jewelry, home decorating and giftware, and as a result of Opposer’s efforts, Opposer’s ELLE-branded magazines and merchandise have resulted in annual sales of millions of dollars in the United States. The ELLE mark has become distinctive of Opposer’s goods and services, and has come to represent enormous goodwill for Opposer.

ANSWER: Applicant is without knowledge sufficient to form a belief as to the truth or relevance of the allegations contained in paragraph 4 and therefore Applicant denies the same.

5. The Trademark Trial and Appeal Board has determined that Opposer’s mark ELLE “is famous in connection with its magazine and within the fashion industry generally, and is entitled to broad protection.” *Hachette Filipacchi Presse v. Ev International, LLC*, Opp. No. 91174433 (Sept. 5, 2008).

ANSWER: Applicant is without knowledge sufficient to form a belief as to the truth or relevance of the allegations contained in paragraph 5 and therefore Applicant denies the same.

6. Opposer owns U.S. Registration No. 758137, filed November 14, 1962, and issued on September October 8, 1963, for the mark ELLE, for “magazine” in U.S. Class 38; U.S. Registration No. 1314558, filed on November 10, 1983 and issued on January 15, 1985, for the mark ELLE (Stylized), for “stationary—namely, notebooks, writing pads, fountain pens, pencils, pencil holders, indexes, stationary portfolios, notebooks/writing pads, address books, folders” in Class 16; U.S. Registration No. 1732988, filed on December 23, 1991 and issued on November 17, 1992, for the mark ELLE DECOR, for “magazines featuring interior and exterior decoration, architecture, landscaping, gardening and horticulture; cuisine; art and sculpture, artifacts, antiques and collections, furniture; household accessories, accoutrements, and fixtures; critiques of residences; biographical sketches; electronics for the home; national and international lifestyles, travel, tourism and photography” in Class 16; U.S.

Registration No. 1668272, filed on January 10, 1990 and issued on December 17, 1991, for the mark ELLE DECOR (Stylized), for “printed matter and periodicals, namely newspapers, reviews, pamphlets, brochures, newsletters, information or advertising letters, journals and magazines in the field of interior and exterior decorating, architecture, landscaping, gardening and horticulture; cuisine” in Class 16 and “publication of books, magazines, and newspapers” in Class 41; U.S. Registration No. 1767100 filed on August 17, 1989 and issued on April 27, 1993, for the mark ELLE, for, inter alia “production of sound recordings featuring music” in Class 41 and “news agency services; namely gathering and dissemination of news” in Class 42; and U.S. Registration No. 2242315, filed on May 9, 1995 and issued on May 4, 1999, for “telephone communications services, electronic transmission of data, images and sound and documents via computer terminals; electronic transmission of information from data banks via computer terminals” in Class 38, “forums in the field of fashion and beauty; entertainment services, namely providing an on-line entertainment variety show, featuring fashion and beauty” in Class 41 and “licensing of intellectual property; editing of written texts, book reviews, periodicals, magazines and publications of all types regardless of their form, including electronic and digitized publications, compiling data bases and data banks for use by others” in Class 42. Registration Nos. 1732988, 1668272, 1767100 and 2242315 are incontestable under Section 15 of the Trademark Act, 15 U.S.C. § 1065. TARR copies of the foregoing registrations are made of record.

ANSWER: Applicant admits the allegations of paragraph 6.

7. On February 2, 2011, Applicant, Lauren R. Schneider, filed an application to register the mark ELLE SCHNEIDER for “Film and video production; Film and video production consulting services; Film editing; Media production services, namely, video and film production; Multimedia entertainment services in the nature of development, production and post- production services in the fields of video and films; Multimedia entertainment services in the nature of recording, production and post-production services in the fields of music, video, and films; Photography; Photography services; Post-production editing services in the field of music, videos and film; Production and distribution of videos in the field of fashion; Production of films; Script writing services; Writing of articles for periodicals other than for advertising or publicity; Writing of texts other than publicity texts” based on use in commerce with a first-use date of 2006, and a first use in commerce date of 2006. This application was assigned Serial No. 85/240605.

ANSWER: Applicant admits the allegations of paragraph 7.

8. On information and belief, Applicant made no use of the mark ELLE SCHNEIDER prior to the claimed first-use date of 2006. Therefore, Opposer has priority.

ANSWER: Applicant admits the first allegation of paragraph 8 and is without knowledge sufficient to form a belief as to the truth or relevance of the second allegation of paragraph 8 and therefore Applicant denies the same.

FIRST CLAIM: PRIORITY AND LIKELIHOOD OF CONFUSION

9. The mark that Applicant seeks to register, ELLE SCHNEIDER, is highly similar in sound appearance and commercial impression to Opposer's ELLE and ELLE DECOR marks, since the dominant element of Applicant's mark is ELLE. In addition, Opposer co-brands the ELLE mark for products and services, and thus the additional term SCHNEIDER could be viewed as denoting another line extension or co-branding project from Opposer.

ANSWER: Applicant denies the allegations of paragraph 9.

10. Applicant's mark ELLE SCHNEIDER is being used in connection with services that are identical or closely related to the goods and services for which Opposer uses its registered marks ELLE and ELLE DÉCOR and its common law mark ELLE TV.

ANSWER: Applicant denies the allegations of paragraph 10.

11. Based on the similarities of the marks and the goods and services, the public is likely to associate the services offered by the Applicant under the ELLE SCHNEIDER mark with Opposer or with Opposer's ELLE and ELLE DECOR goods and services, or to believe that Applicant's services are sponsored, endorsed or licensed by Opposer, or that there is some relationship between Applicant and Opposer.

ANSWER: Applicant denies the allegations of paragraph 11.

12. For the above reasons, any use of the mark ELLE SCHNEIDER by Applicant is likely to cause confusion, cause mistake or deceive the public, and cause the public to believe that the services offered under the mark ELLE SCHNEIDER emanate from or are otherwise sponsored by or endorsed by Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C § 1052(d).

ANSWER: Applicant denies the allegations of paragraph 12.

AFFIRMATIVE DEFENSES

- A. Goods and services cited in Opposer's Notice of Opposition in Class 41 for U.S. Registration No. 2242315, namely "production of television programs; entertainment services in the nature of a cable television variety show featuring fashion and beauty; video tape film production" were permanently deleted from Opposer's registration for non-use on 11/3/2009 as shown by documents in TSDR. This deletion for non-use occurred after Respondent's first-use date of 2006 for similar goods and services.

- B. No single good and/or service overlaps between Respondent's Application and Opposer's registered marks as found on TARR.
- C. By reason of the foregoing, Opposer's priority is contested; Applicant's use of the mark ELLE SCHNEIDER for stated goods and services predates any use of Opposer's ELLE mark for similar goods and services.
- D. Additionally, ELLE, an ordinary pronoun ("she") in the French language as well as a popular American female name (as proven by the U.S. Government's Social Security website, ssa.gov), is not unique or distinctive as to cause itself to be the dominant element of Applicant's mark.
- E. Opposer's allegation that the TTAB has found that ELLE "is famous in connection with its magazine and within the fashion industry generally," itself denotes that "ELLE" has no fame in relation to the film industry, namely the Applicant's goods & services in the creation and distribution of motion pictures and video content.

SECOND CLAIM: DILUTION

- 13. Opposer repeats and realleges all claims set forth in Paragraphs 1 through 12 as if fully set forth herein.

ANSWER: Applicant repeats and incorporates the admissions and denials of paragraphs 1 through 13 hereof as if fully set forth herein.

- 14. The ELLE mark is inherently distinctive, has been used in commerce since 1985 in connection with magazines, and has been used under license for many years for a variety of related merchandise. The ELLE mark is the subject of numerous federal trademark registrations, some of which are incontestable. As a result, the ELLE mark is widely recognized by the public in the United States as a designation of source of Opposer's goods, and is famous.

ANSWER: Applicant is without knowledge sufficient to form a belief as to the truth or relevance of the allegations contained in paragraph 14 and therefore Applicant denies the same.

- 15. The ELLE SCHNEIDER mark was adopted and the application at issue was filed long after Opposer's ELLE mark became famous.

ANSWER: Applicant is without knowledge sufficient to form a belief as to the truth or relevance of the allegations contained in paragraph 15 and therefore Applicant denies the same.

16. By virtue of the similarity between Applicant's ELLE SCHNEIDER mark and the ELLE mark, the fame of the ELLE mark, and the exclusive association between the ELLE mark and the Opposer, registration of the mark in the application is likely to dilute Opposer's ELLE mark by impairing the distinctiveness of Opposer's ELLE mark in violation of Section 43(c) of the Lanham Act, 15 U.S.C § 1125(c), and would be inconsistent with Opposer's statutory grant of exclusive rights in the ELLE mark.

ANSWER: Applicant denies the allegations of paragraph 16.

THIRD CLAIM:

17. Opposer repeats the allegations contained in Paragraphs 1 through 16 as if fully set forth herein.

ANSWER: Applicant repeats and incorporates the admissions and denials of paragraphs 1 through 17 hereof as if fully set forth herein.

18. On information and belief, including based on the allegations set forth in the Applicant's discovery responses in this proceeding, Applicant is using the name "Elle Schneider" as her personal name and/or pseudonym, and not as a service mark in connection with the advertisement, promotion or provision of the Application Services.

ANSWER: Applicant denies the allegations of paragraph 18.

19. Because Applicant is using ELLE SCHNEIDER as a personal name and/or pseudonym, and not as a service mark in connection with some or all of the Application Services, Applicant is not entitled to registration of the ELLE SCHNEIDER mark in connection with such services.

ANSWER: Applicant denies the allegations of paragraph 19.

20. Further, on information and belief, the Application Services are not being provided to third parties but are personal services of Ms. Schneider provided for her own benefit and do not qualify as services that can be subject to registration. Applicant has sought to obtain trademark rights to which she is not entitled.

ANSWER: Applicant denies the allegations of paragraph 20.

21. By reason of the foregoing, Opposer will be damaged by the registration of the ELLE SCHNEIDER mark to Applicant.

ANSWER: Applicant denies the allegations of paragraph 21.

AFFIRMATIVE DEFENSES

- A. Opposer's statement of "on information and belief" incorrectly implies admission of Applicant's Mark as solely pseudonym and/or personal name within Applicant's responses to Opposer's requests and interrogatories during discovery period. Applicant repeatedly denies Opposer's allegations that Applicant's mark ELLE SCHNEIDER solely represents a pseudonym and/or personal name alone, but also represents the body of tangible, creative services rendered to clients.
- B. In Applicant's field, the motion picture industry, it is atypical for service marks associated with individuals to be advertised in a traditional sense, i.e. through print advertising or trade channels, and this method of advertising is considered inappropriate and unprofessional. Applicant's lack of advertising in this manner should not be seen as lacking in promotion of her goods & services, or as solely providing services for Applicant's "own benefit".
- C. Applicant denoted in her initial Application that service mark identified a living individual.

Applicant respectfully requests that this opposition be dismissed.

Respectfully submitted,

Lauren R. Schneider, Applicant

/lrs/

Dated: Los Angeles, California
February 28, 2013

465 N Summit Avenue,
Pasadena, CA, 91103

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was served by email Michael Chiappetta of
FROSS ZELNICK LEHRMAN & ZISSU, P.C., Attorneys for Opposer, this 28th of February
2013.

Lauren R. Schneider, Applicant

/lrs/
